

Application Serial No.: 09/732,008

Attorney Docket No. 019213-0311422

In Response to Office Action mailed March 9, 2006

REMARKS

In response to the Final Office Action mailed March 9, 2006 (hereinafter "Office Action"), no claims have been amended, cancelled, or newly added. Therefore, claims 1-55 are pending. In view of the following comments, reconsideration and allowance of all the claims pending in the application is respectfully requested.

SPECIFICATION

The Examiner has objected to the Abstract as allegedly including language that may be implied. *See* Office Action at 2-3. Although Applicant disagrees with the Examiner's objection, the Abstract has been amended in an effort to expedite prosecution. Accordingly, withdrawal of this objection is respectfully requested.

RESTRICTION REQUIREMENT

The Examiner has restricted claims 42-55 as allegedly being directed to an independent or distinct invention. *See* Office Action at 2. In particular, the Examiner alleges that the system of claims 42-55 can be used in a materially different process of using the product. By implication, the Examiner's position is that claims 1-41 constitute the process for using the product of claims 42-55. Applicant traverses the restriction requirement for at least the reasons that the restriction requirement is improper for several reasons.

The restriction requirement is improper for at least the reason that the timing of the restriction requirement contradicts the procedures set forth in the MPEP. In particular, the MPEP states that "when only a nonfinal written requirement to restrict is made, no action on the merits is given." *See* MPEP § 810. A nonfinal restriction is only to be accompanied by an action on the merits when "a requirement for restriction or election is made via telephone and applicant makes an oral election of a single invention." *See id*; *see also* MPEP § 812.01. Moreover, a restriction requirement may only be made before a final action. *See* MPEP § 811; *see also* 37 C.F.R. § 1.142(a) (emphasis added). In the present application, the Examiner is presenting a nonfinal

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restriction requirement together with an action on the merits, even though the restriction was not made by telephone and the application did not make an oral election. In addition, the nonfinal restriction is included in a final action, which is clearly prohibited by the aforementioned sections of the MPEP. For at least this reason, the timing of the restriction requirement is improper.

In addition to the timing of the restriction being improper, the Examiner's alleged basis for the restriction is erroneous for several reasons. The Examiner alleges that the product of claims 42-55 could be used in a materially different process of using that product. *See* Office Action at 2. The Examiner's position is erroneous for at least the reason that claims 20-38 are directed to system claims, which cannot be properly characterized as process claims. That is, claims 1-41 cannot be characterized as the process by which the product of claims 42-55 are used because claims 1-41 are not entirely directed to a process. Moreover, claims 42-55 present substantially similar features as presented in claims 1-41 in a modified form to clarify certain aspects of the invention (e.g., claims 20-38 are directed to a "system," as are claims 42-55). For example, claims 20 and 30 recite an "authorization means" for authorizing participants to access client data, while claim 42 authorizes participants to access client data by way of an "authorization module." Each feature of claims 20 and 30 similarly corresponds to at least one feature in claim 42. That claims 42-55 contain additional features is an improper basis for restriction. For at least these reasons, Applicant respectfully submits that the restriction requirement is improper and should be withdrawn.

In addition to the reasons presented above, the fact that system claims 20-38 are grouped with method claims 1-19 and 39-41 demonstrates that Examiner recognizes that the system is not independent and distinct from the method, but rather that the features of the system claims are substantially similar to those of the associated method. Moreover, Examiner's rationale for the restriction requirement is broad and conclusory, and no explanation has been provided as to how the system of claims 42-55 would be used in a materially different process of using the product, nor is any explanation provided describing a materially different process in which the product could be used. Accordingly, Applicant respectfully submits that the restriction requirement is improper and should be withdrawn, and claims 42-55 should be treated on the merits.

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REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-41 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. *See* Office Action at 3-4. Applicant traverses this rejection, for at least the reason that the claims meet the requirements of clarity and precision required by § 112, second paragraph.

The Examiner identifies several claim terms as allegedly failing to provide “clear definition of the meets [sic] and bounds of the term.” *See* Office Action at 3. In particular, the Examiner objects to numerous claim terms, including “collaborate,” “enabling,” and “to interact” in the independent claims. The Examiner also alleges that the language in certain dependent claims, including “events,” “actions,” “client,” and “participants” are unclear.

The Examiner has failed to provide any explanation of why the claim terms remain indefinite, particularly when considered in light of the knowledge of a person having ordinary skill in the art and the extensive Specification. The MPEP sets forth the clarity and precision requirements of § 112, second paragraph, and the Examiner has disregarded the proper standards of claim interpretation during prosecution, while also appearing to actively ignore the Specification. In particular, the MPEP specifies at § 2173.02:

The examiner’s focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is **whether the claim meets threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available**. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, **he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.** (emphasis added).

If the Examiner prefers alternative language to make a claim clearer, the MPEP provides a remedy for such a situation. In particular, if “the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the examiner should suggest improved language to the

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applicant.” MPEP § 2173.02 (emphasis in original). Applicants submit that because the Specification provides ample description of the allegedly indefinite claim language, “the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph.” *Id.* Therefore, this rejection is improper and should be withdrawn.

Although Applicant submits that the claims are sufficiently clear, particularly when read in light of the Specification, portions of the Specification describing the allegedly unclear claim terms are provided herein to demonstrate to the Examiner their meaning and expedite prosecution. The following recitations and citations to the Specification are exemplary only and should not be viewed as limiting. The term “collaborate” is well understood to those skilled in the art, in addition to being used in the Specification. For example, the Specification indicates, among other things, that a team of financial advisors can “collaborate” with a common client to provide financial advice. This is provided, for example, by a common tool enabling participants to interact and share information with a client. *See, e.g.*, Specification at 4-5, 15. All of the allegedly indefinite claim terms are similarly described, i.e., “enabling” (Specification at 12, 16), “to interact” (Specification at 5), “events” (Specification at 17), “actions” (Specification at 17-18), and “clients” and “participants” (Specification at 4-5, 13-14).

The Examiner also continues to reject claims 20-38, alleging that a “system” is vague since it may fall into different statutory categories of invention. Applicant submits that the term “system” is sufficiently clear and is routinely used in patent claims without rejection. The rejection is completely without basis and is clearly improper. No supporting rationale has been provided as to how a system may be interpreted to span multiple statutory categories, nor has Examiner responded to previous arguments challenging the basis of the rejection.

Finally, the Examiner has responded to Applicant’s previous arguments relating to the § 112, second paragraph rejections by indicating that “what may be considered such to one may not be considered such to another.” *See* Office Action at 6. As discussed above, the Examiner cannot reject claims under § 112 simply by choosing to ignore the Specification, which provides ample description of the allegedly indefinite claim terms. Therefore, Applicant requests the Examiner fully consider the teachings of the Specification when responding to Applicant’s

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arguments. For at least the foregoing reasons, the rejections under 35 U.S.C. §112, second paragraph are improper and should be withdrawn.

REJECTIONS UNDER 35 U.S.C. §103

Claims 1-7, 9-17, 19-26, 28-36 and 38-40 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,940,843 to Zucknovich et al.

("Zucknovich"). See Office Action at 4. Claims 8, 18, 27, 37 and 41 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Zucknovich as applied to claims 1-7, 9-17, 19-26, 28-36 and 38 above, and further in view of U.S. Patent No. 6,243,722 to Day et al. ("Day"). See Office Action at 5.

These rejections are traversed for at least the reason that Examiner has failed to make out a *prima facie* case of obviousness. Because Zucknovich fails to teach or suggest several claimed features, in addition to being nonanalogous art, the rejection is improper and should be withdrawn.

Referring to claim 1, Zucknovich fails to teach or suggest "enabling authorization of one or more participants to access client data." In the present invention, the collaboration tool enables participants to serve a client (Specification, pg. 4 lines 16-17). To protect security and address confidentiality concerns, and for other reasons discussed at length in the Specification, a user can grant participants access to the user's data (Specification, pg. 4 lines 7-8), i.e., the "client data" is specific to the client (Specification, pg. 12 lines 14-15, "Client data...may include *personal* data and other related *client information*) (emphasis added). On the other hand, Zucknovich appears to allow a contributor to regulate access to research reports regarding third parties (col. 1 line 23 – col. 2 line 24). The portions of Zucknovich relied upon by the Examiner as allegedly teaching this feature, e.g., col. 1, lines 50-56, do not relate to "enabling authorization of one or more participants to access client data" for at least the reason that the data for which access is authorized is related to a third party, and is therefore not "client data" specifically related to the authorizing entity, as claimed.

The distinction highlighted above carries into many other features of the claimed invention, further distinguishing the claimed invention over Zucknovich. The Examiner

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apparently takes the position that the research contributors of Zucknovich are the claimed "client." Because several features of claim 1 relate to the data provided to the electronic collaboration being "client data," Zucknovich's third-party research system is unrelated to the "client data." In fact, assuming *arguendo* that the "contributor" of Zucknovich is the claimed "client," there is nothing within the disclosure of Zucknovich that could reasonably be considered "client data" since all of the data provided by Zucknovich relates to third parties. For at least this reason, the rejection of claim 1 is improper and should be withdrawn.

The Examiner has failed to make out a *prima facie* case of obviousness since there is no teaching, suggestion, or motivation to modify the reference as alleged. A motivation to modify a reference may be drawn from the nature of the problem to be solved, the teachings of the prior art, or the knowledge of persons having ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The Examiner alleges that a person having ordinary skill in the art would have been motivated to modify the reference in the manner claimed since "Zucknovich [sic] teaches that research providers require interaction with those who desire their work product." This misses the mark because Zucknovich is directed to one-way distribution of third-party research from a contributor to a user who may desire to read or access the research report. In contrast, the claimed "collaboration" is an interactive process involving the "exchange of client data" between one or more participants and a client. Zucknovich does not teach or suggest "collaboration," as Zucknovich is merely concerned with distributing data and regulating access to the data. For at least this reason, the rejection of claim 1 is improper and should be withdrawn.

In addition to failing to teach or suggest several claim features, the rejection is improper because Zucknovich is directed to nonanalogous art. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MPEP § 2141.01(a). As discussed above, Zucknovich's field of endeavor is distribution of research reports from research providers to investors. The content of the research has no relationship to the recipients; the research is accessible by many different parties, and the research relates to third-parties. In addition, the problem addressed by

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Zucknovich is compliance with Securities and Exchange Commission (SEC) laws (col. 1 lines 45-57). In contrast, Applicant's field of endeavor and problem addressed is providing collaboration between clients and financial service providers. The collaboration enables financial service providers and clients to work together to meet the needs of the client. These are clearly distinct fields of endeavor and distinct problems, for at least the reason that distribution and regulation of access to third-party research in accordance with SEC requirements is unrelated to financial service providers collaborating with clients to provide financial advice and services.

In response to Applicant's previous arguments that Zucknovich was nonanalogous art, the Examiner alleged that Zucknovich is analogous because Zucknovich is "both in the field of applicant's endeavor and is reasonable [sic] pertinent to the particular problem with which the applicant is concerned." See Office Action at 7. Applicant respectfully submits that this argument is conclusory in nature and the Examiner has failed to identify either the field of endeavor or the particular problem addressed by either Zucknovich or the claimed invention, let alone explain why the fields of endeavors or problems are analogous. Applicant further maintains that the Examiner has failed to address these points, which have been raised in the prior response, and respectfully requests the Examiner consider the field of endeavor and problems addressed when responding to Applicant's arguments.

Many of the arguments presented in the present response were previously presented in the response dated December 13, 2005. The Examiner has failed to provide a convincing line of reasoning for finding the arguments to be not persuasive. See Office Action at 6-7. First, Examiner summarily dismisses the detailed arguments by stating that the claim terms "are given their broadest possible meaning." See Office Action at 6. This is simply an incorrect statement of how claims are to be interpreted during prosecution, as claims are not to be given "their broadest *possible* meaning," but rather, they must be given their broadest *reasonable* interpretation *in light of the specification*. It is improper to ignore the Specification when construing claim terms and Applicant respectfully requests that Examiner consider the present arguments in light of the Specification and provide a specific rationale as to how the teachings of Zucknovich are alleged to correspond to the claimed features. As is, Examiner's position is unclear in addition to being based on a misstatement of the law.

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For at least the foregoing reasons, the rejection of claim 1 is improper and should be withdrawn. The secondary reference, Day, fails to cure the deficiencies of Zucknovich highlighted above. Independent claims 11, 20, 30, and 39 contain similar features to those discussed above in reference to independent claim 1. Therefore, the rejections of these claims are likewise improper for at least the reasons discussed for claim 1. Dependent claims 2-10, 12-19, 21-29, 31-38, and 40-41 depend from and add features to one of claims 1, 11, 20, 30, and 39. Therefore, the rejections of these claims are likewise improper for at least the same reasons.

NON-STATUTORY DOUBLE PATENTING REJECTION

Claims 1-37 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-56 of co-pending Application No. 09/877,926. *See* Office Action at 5-6.

The rejection for double patenting is believed to be premature as no claims have been allowed. In the event necessary, upon the indication of allowable subject matter, Applicant will consider filing a Terminal Disclaimer.

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CONCLUSION

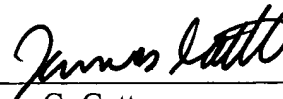
Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: July 10, 2006

Respectfully submitted,

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